

REMARKS

Reconsideration and the timely allowance of the pending claims, in view of the following remarks, are respectfully requested.

Claims 1, 3, 9, 11, and 14-20 are currently pending. By this Amendment, claim 1 has been amended to incorporate former claim 2. Claims 3, 11, and 14-19 have been amended to provide a clearer presentation of the claimed subject matter. No new matter is therefore added by these amendments. Therefore, claims 1, 3, 9, 11, and 14-20 remain pending, of which claims 1, 9 and 20 are independent claims.

Prior Art Rejections:

Claim 1, recites, inter alia, wherein the phenolic compound represented by the formula (I) comprises phenol or a C₁₋₄alkylphenol.

Takahasi teaches a process where florenone is reacted with phenol using HS(CH₂)₂CO₂H/HCL as a catalyst. However, Takahasi does not teach the use of a phenolic compound represented by the recited formula (I) that comprises phenol or a C₁₋₄alkylphenol, as recited by applicant in claim 1.

Fennhoff and Shinagawa, singularly or in combination, fail to disclose what is missing in Takahasi. Fennhoff and Shinagawa discloses processes for reacting florenone, but do not teach the use of a phenolic compound represented by the recited formula (I) that comprises phenol or a C₁₋₄alkylphenol, as recited by applicant in claim 1. Claims 3, 5 and 8 are similarly allowable as they depend upon claim 1.

Thus, for the above cited reasons, Takahasi, Fennhoff and Shinagawa fail to disclose all of the elements recited in applicants' claimed invention, thereby failing to make applicant's invention a predictable use of prior art elements. Further, Takahasi, Fennhoff and Shinagawa fail to provide a basis to establish obviousness under additional rationales, including simple substitution for one known element for another to obtain predictable results, use of known technique to improve similar devise in the same way, applying a known technique to a known device ready for improvement to yield predictable results, obvious to try, and the presence of a teaching, motivation, or suggestion. Thus, reconsideration and withdrawal from this rejection, and allowance of claims 1, 3, 5 and 8 are respectfully requested.

Claim 9 recites, *inter alia*, wherein the proportion (weight ratio) of the thiol relative to hydrogen chloride contained in the hydrochloric acid aqueous solution is 1.0/0.1 to 1.0/3.0 and the proportion (weight ratio) of fluorenone relative to the thiol is 1.0/0.05 to 1.0/0.3.

Takahasi teaches a process where florenone is reacted with phenol using $\text{HS}(\text{CH}_2)_2\text{CO}_2\text{H}/\text{HCL}$ as a catalyst. However, Takahasi does not teach the proportion (weight ratio) of the thiol relative to hydrogen chloride contained in the hydrochloric acid aqueous solution is 1.0/0.1 to 1.0/3.0 and the proportion (weight ratio) of fluorenone relative to the thiol is 1.0/0.05 to 1.0/0.3, as recited by applicant in claim 9.

Fennhoff and Shinagawa, singularly or in combination, fail to disclose what is missing in Takahasi. Fennhoff and Shinagawa discloses processes for reacting florenone, but do not teach the proportion (weight ratio) of the thiol relative to hydrogen chloride contained in the hydrochloric acid aqueous solution is 1.0/0.1 to 1.0/3.0 and the proportion (weight ratio) of fluorenone relative to the thiol is 1.0/0.05 to 1.0/0.3, as recited by applicant in claim 9. Claims 11 and 14-19 are similarly allowable as they depend upon claim 9.

Thus, for the above cited reasons, Takahasi, Fennhoff and Shinagawa fail to disclose all of the elements recited in applicants' claimed invention, thereby failing to make applicant's invention a predictable use of prior art elements. Further, Takahasi, Fennhoff and Shinagawa fail to provide a basis to establish obviousness under additional rationales, including simple substitution for one known element for another to obtain predictable results, use of known technique to improve similar devise in the same way, applying a known technique to a known device ready for improvement to yield predictable results, obvious to try, and the presence of a teaching, motivation, or suggestion. Thus, reconsideration and withdrawal from this rejection, and allowance of claims 9, 11 and 14-19 are respectfully requested.

Claim 20 recites, *inter alia*, wherein the proportion (weight ratio) of the γ -mercaptopropionic acid relative to hydrogen chloride contained in the hydrochloric acid aqueous solution is 1.0/0.1 to 1.0/3 and the proportion (weight ratio) of fluorenone relative to γ -mercaptopropionic acid is 1/0.05 to 1/0.3.

Takahasi teaches a process where florenone is reacted with phenol using $\text{HS}(\text{CH}_2)_2\text{CO}_2\text{H}/\text{HCL}$ as a catalyst. However, Takahasi does not teach the proportion (weight ratio) of the γ -mercaptopropionic acid relative to hydrogen chloride contained in the hydrochloric acid aqueous solution is 1.0/0.1 to 1.0/3 and the proportion (weight ratio) of

fluorenone relative to γ -mercaptopropionic acid is 1/0.05 to 1/0.3, as recited by applicant in claim 20.

Fennhoff and Shinagawa, singularly or in combination, fail to disclose what is missing in Takahasi. Fennhoff and Shinagawa discloses processes for reacting fluorenone, but do not teach the proportion (weight ratio) of the γ -mercaptopropionic acid relative to hydrogen chloride contained in the hydrochloric acid aqueous solution is 1.0/0.1 to 1.0/3 and the proportion (weight ratio) of fluorenone relative to γ -mercaptopropionic acid is 1/0.05 to 1/0.3, as recited by applicant in claim 20.

Thus, for the above cited reasons, Takahasi, Fennhoff and Shinagawa fail to disclose all of the elements recited in applicants' claimed invention, thereby failing to make applicant's invention a predictable use of prior art elements. Further, Takahasi, Fennhoff and Shinagawa fail to provide a basis to establish obviousness under additional rationales, including simple substitution for one known element for another to obtain predictable results, use of known technique to improve similar device in the same way, applying a known technique to a known device ready for improvement to yield predictable results, obvious to try, and the presence of a teaching, motivation, or suggestion. Thus, reconsideration and withdrawal from this rejection, and allowance of claim 20 is respectfully requested.

Conclusion.

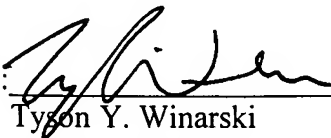
All matters having been addressed and in view of the foregoing, Applicant respectfully requests the entry of this Amendment, the Examiner's reconsideration of this application, and the immediate allowance of all pending claims.

Applicant's representative remains ready to assist the Examiner in any way to facilitate and expedite the prosecution of this matter. If any point remains in issue which the Examiner feels may be best resolved through a personal or telephone interview, please contact the undersigned at the telephone number listed below.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

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